

REMARKS

Claims 1-33 are currently pending. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Finality of Office Action

Applicants acknowledge that, this being the second Office action in connection with this Application, the Examiner is within his right to deem the Office action final. However, it should be noted that the initial Office action in connection with this application was mailed on March 29, 2004; more than two years prior to the mailing of the present Office action. Applicants therefore respectfully submit that, having thus far been denied, through no fault of their own, an opportunity to fully develop a clear issue with regard to allowability of the claims, it would be equitable for the Examiner to withdraw the finality of the present Office action and allow Applicants an opportunity to fully prosecute the application. Accordingly, such action is respectfully requested.

Rejections under 35 U.S.C. §101 and 35 U.S.C. §112

Claims 31-33 and 8-27 stand rejected under 35 U.S.C. §101 and 35 U.S.C. §112 as being unsupported by either a specific asserted utility or a well-established utility. In response, Applicants have amended claims 8-27 and 31-33 to overcome the subject rejections and therefore respectfully request that the rejections be withdrawn.

Rejections under 35 U.S.C. §103

Claims 1-13 and 23-33 stand rejected under 35 U.S.C. §103 as being anticipated by U.S. Patent No. 6,414,950 to Rai et al. ("Rai") in view of U.S. Patent No. 6,553,015 to Sato ("Sato"). Claims 14-22 stand rejected under 35 U.S.C. §103 as being unpatentable over Rai in view of Sato and further in view of U.S. Patent No. 6,252,851 Sin et al. ("Sin"). Applicants traverse these rejections on the grounds that the above references are defective in establishing a prima facie case of obviousness with respect to all these claims.

As provided in MPEP §2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP §2142,

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

It is submitted that, in the present case, the Examiner cannot factually support a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

In general, Applicants submit that the Examiner has failed to “bear the initial burden of factually supporting [a] *prima facie* conclusion of obviousness” because he has failed to specifically identify what teachings of the cited references he believes to read on which of the claim limitations. Instead, the Examiner has merely provided a general summary of the teachings of each reference and then generally asserted that the references teach Applicants’ claimed invention, without specifying why he believes those teachings are relevant to specific elements of the claims. For example, the Examiner does not specify exactly what deficiencies of Rai in particular Sato is meant to remedy, what features of the two references are being combined and in what manner they are being combined. Moreover, the summary of the Sato reference indicates that it is supported at “Col. 20, lines 4 plus” of that reference; however, Sato contains only 12 columns. As a result, Applicants are left to piece together the Examiner’s argument based on a general explanation of the references. This leaves Applicants in the untenable position of having to make the Examiner’s argument, and then provide a counter-argument thereto. Applicants acknowledge that there is no requirement *per se* that the Examiner provide a one-to-one correspondence between the cited references and the claim elements; however, in the present case, the Examiner’s argument is so general as to fail to meet the burden placed upon him by the MPEP, as cited above.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

Claim 1, as amended, recites, in part, “upon initiation of the handoff, sending a first message to the first agent requesting the first agent to buffer at the first agent all packets being sent to the mobile node” and “responsive to the completing, sending a second message to the first agent requesting the first agent to forward the packets buffered at the first agent to the second agent”. As has been previously noted, and as implicitly acknowledged by the Examiner, Rai is silent with regard to sending of a any buffering request messages to the first agent for causing the first agent to buffer at the first agent all packets destined for the mobile node (“first message”) and for causing the first agent to forward the packets buffered at the first agent to the second agent (“second message”). Sato fails to remedy the deficiencies of Rai in this regard.

In particular, as indicated above, while the Examiner the Examiner cites Sato as teaching a long list of steps in implementing a handoff method. No where in these steps is disclosed the above-noted elements of claim 1. It would appear that the Examiner equates Sato’s teaching of “holding the upstream ATM cells in a mobile-site buffer immediately following the transmission of the handoff request message”;

however, the “upstream ATM cells” are not “packets being sent to the mobile node”. Moreover, Sato fails to teach “responsive to the completing [of the handoff], sending a second message to the first agent requesting the first agent to forward the packets buffered at the first agent to the second agent.”

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and any rejection of claim 1 under 35 U.S.C. §103 should be withdrawn. Claims 2-6 depend from and further limit claim 1 and are therefore also deemed to be in condition for allowance for at least the same reasons as claim 1.

Claims 7, 8, 23, 28, and 31 include limitations similar to those of claim 1 and are therefore also allowable for at least the same reasons as claim 1. Claims 9-22, 24-27, 29, 30, 32, and 33 depend from and further limit claims 7, 8, 23, and 31 and are therefore also deemed to be in condition for allowance for at least that reason.

2. The Combination of References is Improper

There is still another, mutually exclusive, and compelling reason why the Rai and Sato patents cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides

[T]he examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. . . . The examiner must put aside knowledge of the applicant’s disclosure, refrain from using hindsight, and consider the subject matter claimed ‘as a whole.’

Here, neither Rai or Sato teaches, or even suggests, the desirability of the combination of claim 1, for at least the reasons set forth above. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of claim 1.

In this context, the MPEP further provides at §2143.01

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination of the Rai and Sato patents arises solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in either reference for the combination as applied to claim 1. Rai teaches the sending of buffered data from a first

agent of a first wireless hub to a second agent of a second wireless hub. Sato teaches and claims a completely different mobile communications buffering system, one in which a mobile node, and not an agent of a wireless hub, performs the buffering and the subsequent sending of buffered data. Sato's algorithm used to provide buffer management for a system that buffers data in the mobile node could not be applied to, nor combined with, Rai's mobile communication system that teaches the buffering of data in an agent of a wireless hub, and not in the mobile node. Sato's algorithm is not compatible with the system as taught in Rai. If Sato's algorithm were to be applied to the system taught in Rai, the intended purposes of both Rai and Sato would be destroyed. Notably, this argument, which was also made by Applicants' in the amendment filed June 29, 2004, was not addressed by the Examiner in the final Office action.

In view of the foregoing, it is apparent that none of the cited references provides any incentive or motivation supporting the desirability of the combination. Therefore for this mutually exclusive reason, the Examiner's burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. §103 is not applicable to the pending claims.

Conclusion

It is clear from the foregoing that independent claims 1, 7, 8, 23, 28, and 31 are in condition for allowance. Claims 2-6, 9-22, 23-27, 29-30, and 32-33 depend from and further limit independent claims 1, 7, 8, 23, and 31, and are therefore also deemed to be in condition for allowance.

An early formal notice of allowance of claims 1-33 is requested.

Respectfully submitted,



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